

REMARKS

Claim Disposition

Claims 1-57 are pending. The Office Action further indicates that claims 4, 5, 10-23, 36, 37, 40, 42-45, 47, 48, and 53-57 have been withdrawn from consideration.

Claims 2, 6, 7, 8, 10-23, 45, 47, 48, and 55-57 are cancelled without prejudice or disclaimer.

Claims 1, 5, 9, 24-27, 33, 35, 39, 41, 46, and 49 are amended as further explained below.

Applicants hereby reserve the right to file continuing applications or take any other such appropriate measure to prosecute the subject matter cancelled by cancellation or amendment.

New claims 58-79 are added.

Claims 1, 3-5, 9, 24-44, 46, 49-54, and 58-79 will be pending in the application upon entry of this amendment.

No new matter is entered by way of this submission.

Support for claim amendments

The claim amendments set forth above are supported by the original specification and claims, including EXAMPLES 49, 50, 92, 93, 94, 96, 97, 98, 99, 100, 104, 105, 109, 110, and 111, and as further explained below.

Claim 1 is amended to set forth: "...J, if present, is a single 3 to 10-membered saturated or partially unsaturated alkylene chain extending that extends from the R⁷/R⁷' cycloalkyl or from the carbon atom to which R⁷ is attached to one of R_d, R_j, R_x, R_y or R¹¹' G to form and forms a macrocycle ...", the amendment supported, for example, by original claim 1, including formula VI; and specification page 14, including formula VIhe; as well as EXAMPLES 49, 50, 92, 93, 94, 96, 97, 98, 99, 100, 104, 105, 109, 110, and 111. As explained in further detail below, Claim 1 is further amended as set forth above, in order to present the macrocyclic compounds comprehended by the claim as amended, to correct minor inadvertent typographical errors, and to place the claim in better condition for allowance. The scope of the claim is not extended beyond that which was included in the claim as originally filed, by way of this amendment. Therefore, the amendments are well-supported, for example, by the claim as originally filed and throughout the specification.

Claim 5 is amended to remove the recitation "...preferably methyl..."; the amendment supported for example, by original claim 5.

Claim 9 is amended to have dependency on claim 1, consistent with the above-explained amendments to claim 1, and cancellation of claims 6 and 7. The amendment is supported, for example, by original claims 1, 6, and 7.

Claim 24 is amended to set forth “...wherein W is –O–”; the amendment supported by, for example, by original claims 1 and 24.

Claim 25 is amended to set forth dependency to claim 24, consistent with the above-explained amendments to claim 1, and cancellation of claim 23. The amendment is supported, for example, by original claims 1 and 25.

Claim 26 is amended to remove the recitation “...or preferably a bond...”; the amendment supported for example, by original claim 26.

Claim 27 is further amended as set forth above, in order to present the Claim in independent form, to incorporate the limitations of Claim 1 consistent with the claim 1 amendments presented herein including the limitation “...W is –O-, or –S-...” ; and to retain the limitations of original claim 27 with respect to positions R⁸, R⁹ and R¹⁰. The claim is further amended to correct inadvertent typographical errors and to place the claim in better condition for allowance.

Amended Claim 27 is supported, for example, by original claims 1, and 27, and the bridging paragraph of specification pages 17-18.

Claim 35 is amended to correct an inadvertent typographical error.

Support for the amendments of claims 39 and 40 is found, for example, in claim 40 as originally filed.

The amendments to claims 41-44 as set forth above, are supported, for example, by original claim 1, and original claims 41-44 respectively.

Claim 46 is amended to have dependency on claim 1, consistent with the above-explained amendments to claim 1 and cancellation of claim 2, and as further set forth above. The amendment is supported, for example, by original claims 1, 2, and 46.

Claim 49 is amended to remove the recitations "...such as methyl..." and "...such as acetyl..."; the amendment supported for example, by original claim 49.

Support for the new claims is provided throughout the specification and the claims as originally filed, for example, as provided in:

original claim 5, and specification page 28, line 23, for new claim 58;

original claims 1 and 9, and specification page 27, lines 20-24, for new claim 59;

original claims 1 and 41, for new claim 60;

original claims 1, 3, 27, and the bridging paragraph of specification pages 17-18 for new claim 61;

original claims 1, 5, 27, and the bridging paragraph of specification pages 17-18 for new claims 63 and 64;

original claims 1, 24, 27, and the bridging paragraph of specification pages 17-18 for new claim 65;

original claims 1, 26, 27, and the bridging paragraph of specification pages 17-18 for new claim 66;

original claims 1, and 27, specification page 27, lines 20-24 and the bridging paragraph of pages 17-18 for new claim 67;

original claims 1, 27, 39, and 41, specification page 29, lines 30-31 and the bridging paragraph of pages 17-18 for new claim 68;

original claims 1, 27, 39, and 41, specification page 29, lines 21-22 and 30-31, and the bridging paragraph of pages 17-18 for new claim 69;

original claims 1, 27, 49, and the bridging paragraph of specification pages 17-18 for new claim 70;

original claims 1, 27, 50, and the bridging paragraph of specification pages 17-18 for new claim 71;

original claims 1, 27, 51, and the bridging paragraph of specification pages 17-18 for new claim 72;

original claims 1, 27, 52, and the bridging paragraph of specification pages 17-18 for new claim 73;

original claims 1, 27, 50, the bridging paragraph of specification pages 17-18; and specification page 14, including formula VIhe for new claim 74;

original claims 1, 27, 39, 41, 52, specification page 29, lines 21-22 and 30-31, and the bridging paragraph of pages 17-18 for new claim 75;

original claims 1, 27, 53, and the bridging paragraph of specification pages 17-18 for new claim 76;

original claims 1, 27, 54, and the bridging paragraph of specification pages 17-18 for new claim 77;

EXAMPLES 49, 50, 92, 93, 94, 96, 97, 98, 99, 100, 104, 105, 109, 110, and 111 for new claim 78;

original claim 53, and EXAMPLES 49, 50, 92, 93, 94, 96, 97, 98, 99, 100, 104, 105, 109, 110, and 111 for new claim 79;

original claims 1, 39 and 42 for new claim 80; and

original claims 1, 43, and 44 for new claim 81.

Reconsideration and Rejoinder

The Office Action indicates that claims 55-57 have been withdrawn from consideration, there being no allowable generic or linking claim; and that claims 4, 5, 10-23, 36, 37, 40, 42-45, 47, 48, 53, and 53-54 have been withdrawn from consideration as being drawn to a nonelected species. Of these claims that are deemed withdrawn from consideration, claims 4, 5, 36, 37, 40, 42-44, 53, and 53-54 remain pending in the application upon entry of this amendment. As set forth above, and further explained in detail below, the claims have been amended to limit the claimed subject matter to the clearly described, and well-exemplified set of macrocyclic compounds. Accordingly, Applicant respectfully submits that a coextensive search and examination of the entire pending claim set will not necessitate any undue burden on the Office. Such search and examination of the entire pending claim set upon entry of the present amendment, inclusive of claim 39 as presently amended and of new claims 53, 54, 62-64, 76, 77, and 79, is respectfully requested.

Alternatively, as claims 4, 5, 36, 37, 39, 42-44, 53, and 54 have dependency on generic claim 1, claims 34 and 33 serving as linking claims respectively for claims 36 and 37, it is respectfully submitted that upon allowance of claim 1, and/or one or more of claims 33 and 34; claims 4, 5, 36, 37, 39, 42-44, 53, and 54 be appropriately rejoined and included in the allowance. Claim 27, as presently amended to independent form, is a generic claim to which claims 62-64, 76, and 77 have dependency, claims 62 and 63 serving as linking claims respectively for claims 63 and 64. Therefore, it is respectfully submitted that upon allowance of generic claim 27 and/or one or more of claims 62 and 63; claims 62-64, 76, and 77 be appropriately rejoined and included in the allowance. Finally, Claims 66, 67, and 68 include dependency on claim 1; Claim 60 serving as a linking claim. Therefore, it is respectfully submitted that upon allowance of generic

claims 1 and/or linking claim 60; claims 66, 67, and 68 be appropriately rejoined and included in the allowance. Notification as to such rejoinder as stated above is respectfully requested.

The rejection under 35 USC §112, second paragraph should be withdrawn

The Office action indicates that claims 1-3, 6-9, 24-35, 38-39, 41, and 46 are rejected under 35 USC §112, second paragraph, for indefiniteness.

As a basis for this rejection, paragraph 5 of the Office Action indicates that the definition of J as presented in claim 1, is unclear. This rejection is respectfully traversed. Nevertheless, to facilitate prosecution and allowance of the present claims under consideration, Claim 1 is amended as stated above, to include the limitations "...J, if present, is a single 3 to 10-membered saturated or partially unsaturated alkylene chain extending that extends from the R⁷/R⁷ cycloalkyl or from the carbon atom to which R⁷ is attached to one of R_d, R_j, R_x, R_y or R¹¹ G to form and forms a macrocycle..." , and "... G is -O-, -NRy-, or -NRjNRj-; Ry is H, C₁-C₃-alkyl; or Ry is J; one R_j is H and the other R_j is H or J; ...". Therefore, this rejection of the claims under consideration is clearly obviated.

Paragraphs 6 of the Office Action indicates insufficient antecedent basis for the recitation of "the formula VI..." in line 1 of claim 1. This rejection is obviated by deletion of the word "the" from line 1 of claim 1.

In light of all of the above, Applicants request that the rejection of claims 1-3, 6-9, 24-35, 38-39, 41, and 46 under 35 USC §112, second paragraph, be withdrawn, and not extended to the new claims

The rejection under 35 USC §112, first paragraph, should be withdrawn

Paragraph 12 of the Office action indicates that claims 1-3, 6-9, 24-35, 38-39, 41, 46 , and 49-52 are rejected under 35 USC §112, first paragraph, for failing to comply with the written description requirement.

This rejection is respectfully traversed. Nevertheless, to facilitate prosecution and allowance of the present claims under consideration, independent claims 1 and 27 are amended as stated above, to claim the clearly described, and well-exemplified group of macrocyclic compounds. More particularly, claims 1 and 27 are amended to include the limitation "J is a single 3 to 10-membered saturated or partially unsaturated alkylene chain that extends from the R⁷/R⁷ cycloalkyl to G and forms a macrocycle..." , and "... G is -NRy-, or -NRjNRj-; Ry is J;

one Rj is Hsubmit and the other Rj is J; ...". The claims are further amended to include the limitation "q' is 0 and k is 1", thereby rendering a 5-membered ring; and to include the limitation "...W is -O- or -S-...". The remaining variables are further clearly described substitutions within, and around the clearly described macrocyclic structure. Even furthermore, the description includes numerous members of representative species of the presently claimed invention. See for example, EXAMPLES 49, 50, 92, 93, 94, 96, 97, 98, 99, 100, 104, 105, 109, 110, and 111.

Accordingly, the claimed invention is drawn to a group of clearly described, and well-exemplified group of macrocyclic compounds. Therefore, Applicants submit that the specification provides adequate written description for the claimed genus, and reasonably conveys to one skilled in the relevant art that the inventor (s), at the time the application was filed had possession of the entire scope of the claimed invention.

In light of all of the above, Applicants request that this rejection of the claims under consideration under 35 USC §112, first paragraph, be withdrawn, and not extended to the new claims.

Double Patenting

The Office Action indicates that claims 1-3, 6-9, 24-35, 38-39, 41, 46 , and 49-51 are provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 8-9 of copending application NO. 11/995, 827. This rejection is clearly obviated by the amendments to claim 1 and 27 as set forth above to include the recitation "...W is -O- or -S-...". Accordingly, applicants request that this rejection of the claims under consideration be withdrawn and not extended to the new claims.

The Office Action further indicates the following provisional rejections on the grounds of nonstatutory obviousness-type double patenting:

rejection of claims 1-3, 6-9, 24-35, 38-39, 41, 46 , and 49-52 as being unpatentable over claims 1-15, 25 and 27 of copending application NO. 11/995,900;
rejection of claims 1-3, 6-9, 24-35, 38-39, 41, 46 , and 49-52 as being unpatentable over claims 1-2, 4-11, and 13-14 of copending application NO. 11/995,835;
rejection of claims 1-3, 6-9, 24-35, 38-39, 41, 46 , and 49-52 as being unpatentable over claims 25-35 of copending application NO. 11/632, 102; and
rejection of claims 1-3, 6-9, 24-35, 38-39, 41, 46 , and 49-52 as being unpatentable over claims 1-6, and 8-9 of copending application NO. 11/995,869.

While not conceding to these rejections of the claims under consideration over copending applications 11/995,900, 11/995,835, 11/632, 102, and 11/995,869; Applicants respectfully

request that these provisional rejections be held in abeyance until the allowability of the present claims is acknowledged in consideration of the present amendment and response.

CONCLUSION

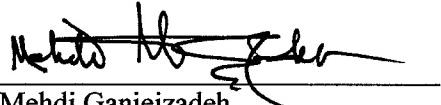
In light of all of the above Amendments and Remarks, Applicants submit that all the claims are now in condition for allowance, and an appropriate notice informing the Applicant of such allowance is respectfully solicited.

Authorization for a three month extension fee under 37 CFR 1.136(a) is submitted herewith. It is not believed that any other fees are due with this response. However, in the event that there are any fees associated with the filing of this response, the commissioner is hereby authorized to charge the appropriate amount to Deposit Account number 12-2136.

Should the examiner have any questions regarding this submission, or in the event that a telephone interview may otherwise expedite the prosecution of this case, the examiner is invited to contact the undersigned at (734) 213-1029.

Respectfully submitted,

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